

PETITION

Return to Petitioner

**CARBIDE CORPORATION, CHEVROLET SALES CORPORATION,
STONEMARK CORPORATION, PETROLEUM LUBRICATING
OILS OF ALBERTA, NASS KEMWORTHY CORPORATION,
ECON-WALSH CORPORATION and ECON-WALSH SERVICE
PAPER COMPANY,**

Respondents.

**PETITIONER'S REPLY BRIEF IN SUPPORT OF
PETITION FOR WRIT OF CERTIORARI**

**WILLIAM J. RAPP,
Counsel for Petitioner.**

SUBJECT INDEX.

	PAGE
Petitioner's Reply Brief in Support of Petition for Writ of Certiorari	1
Answer to the Respondent's Comments on Petitioner's Reasons for Granting the Writ	7
Answer to "Other Pertinent Comments on Petition and Brief"	11
Conclusion	23

CASES CITED:

<i>Bates v. Coc</i> , 98 U. S. 51	20, 20n
<i>Diamond Rubber Co. v. Consolidated Tire Co.</i> , 220 U. S. 428	15, 16
<i>Hughes v. United States</i> , 71 U. S. 232 (4 Wallace 232)	14, 14n
<i>Jones v. Gould</i> , No. 1, 145 App. Div. 271.....	14, 14n
<i>Loom Co. v. Higgins</i> , 105 U. S. 580	20, 20n
<i>Magnum Co. v. Coty</i> , 262 U. S. 160	23
<i>Morgan v. Daniels</i> , 153 U. S. 120	2, 2n, 10, 18
<i>Parks v. Booth</i> , 102 U. S. 96	20, 20n
<i>Pueblo De Taos v. Archuleta</i> , 64 Fed. (2d) 807.....	14, 14n
<i>Smith v. McCool</i> , 83 U. S. 560	14, 14n

IN THE
Supreme Court of the United States
OCTOBER TERM, 1946.
No. 1338.

RAYMOND DE FILIPPIS,

Petitioner,

—against—

CHRYSLER CORPORATION, CHRYSLER SALES CORPORATION,
STUDEBAKER CORPORATION, STUDEBAKER SALES CORPORATION OF AMERICA, NASH KELVINATOR CORPORATION, BORG-WARNER CORPORATION and BORG-WARNER SERVICE PARTS COMPANY,

Respondents.

**PETITIONER'S REPLY BRIEF IN SUPPORT OF
PETITION FOR WRIT OF CERTIORARI.**

That the case presents substantial propositions of law, we believe, is ascertainable from a reading of the petition and brief submitted by the petitioner.

The statement at the bottom of page "1" and the top of page "2"* , to the effect, that a statement appearing in the appellant's brief in the Court of Appeals that there was no substantial dispute with respect to the applicable law, even if such statement were a part of the record of this Court, which we respectfully state is not the fact, certainly does not mean that there are no questions of law before this Court, as the petition and the brief in support of it, show.

* Refers to Respondent's Brief.

N. B. Borg-Warner in this case is defending for all respondents. It will, therefore, be referred to as "respondent" in the singular.

The attempt on the part of the respondent to establish that the district court was familiar with the devices of the petitioner and of the respondent, should fail. The district court held that the petitioner disclosed to the respondent, nothing novel or patentable. The issuance of a patent to the petitioner under the decision of ¹*Morgan v. Daniels* indicated that the district court was in error in that holding.

The district court held the petitioner's device was not an overdrive and could not, under any circumstances, operate the driven shaft at a greater speed than the drive shaft (R. 373). The Court of Appeals found and held that the petitioner's device *was* capable of overdriving (R. 393). The district court held that the petitioner's mechanism was anticipated by the patent granted to Rex E. Keller, No. 1,734,491 (R. 373). This holding is also contra to *Morgan v. Daniels, supra*. The Keller patent, Exhibit "N", made no claim to overdriving. In the Court of Appeals, we established twelve comparisons showing that the respondent's device was based on the petitioner's description and drawing, and that the Keller patent did not anticipate the petitioner's device. The Court of Appeals made no reference to the Keller patent in its decision.

The Court of Appeals in its decision showed that it did not quite understand the mechanical features of the "1930" free-wheeling device (R. 395), because Exhibit "R" (R. 352) that purports to be an assembly drawing, does not show either by word, number, letter or diagram, anything that resembles, even remotely, a sliding shaft, and the respondent at the bottom of page "7"* , although it describes the "1930" device

¹ *Morgan v. Daniels*, 153 U. S. 120, at page 122.

* Refers to Respondent's Brief.

in some detail, does *not* claim that this "1930" device had a sliding shaft or include a sliding shaft as one of its parts.

We must disagree with the contention of the respondent at page "2"* , that either the district court or the Court of Appeals understood the devices before them. The holding by the district court that the petitioner's device could not overdrive demonstrated conclusively that that Court did not understand the petitioner's device. The holding of the Court of Appeals that the "1930" device had a sliding shaft demonstrated that that Court did not understand the "1930" device, since the "1930" device had no sliding shaft as we have stated in our petition and particularly at page "19":

"* * * At no place, either in the testimony or in the drawing Exhibit 'R', is there anything showing that this '1930 device' had a sliding shaft, nor did the respondent ever claim that this '1930 device' had a sliding shaft. The petitioner offers to produce one of these devices and prove that in it, there is no such thing as a sliding shaft."

The failure on the part of the respondent in its reply to challenge that statement, as well as our offer to produce a "1930" device and establish to the satisfaction of this Court that it has no sliding shaft, we believe, is an admission by the respondent that our statement is correct, and that the "1930" device did not have a sliding shaft.

The respondent's contention at page "2"*,

"The evaluation of these facts does not and

* Refers to Respondent's Brief.

could not depend upon the deposition of any witness because such evaluation depends entirely upon documentary evidence and stipulated mechanical exhibits."

in itself, is sufficient to enable this Court to reverse the Court of Appeals, since Exhibit "R", the only basis for the decision of the Court of Appeals (R. 395) has no value to establish either the manufacture, the existence or the function of the "1930" device. There was no physical exhibit of the "1930" device in Court, nor apparently was it even considered by the district court, as there is no reference to the device in the opinion of the district court, nor is there any finding by the district court, in respect of the "1930" device.

The testimony referring to Exhibit "R" and the manufacture of the "1930" device is hearsay (R. 264). The respondent depends on a date on the drawing (Exhibit "R"), that anyone could have inserted at any time, for its claim that it manufactured this "1930" device at the time claimed by it.

There is no denial in the respondent's brief of the facts set forth in the petition at pages 10, 11, 12 and bottom of page 14 and page 15.

Respondent does not deny that the so-called "1930" device did not contain a sliding shaft. It does not point out where there is any evidence, either oral or in any exhibit, establishing that this device Exhibit "R" (R. 352) had a sliding shaft. The respondent does not deny that the manual lockout referred to by the Court of Appeals (R. 395), which was claimed to have been contained in the "1930" device, differed materially from that element in the petitioner's and the accused devices.

There is no claim by the respondent that it ever manufactured a device using petitioner's elements, *before* petitioner disclosed them to it.

The respondent does not deny that its sole witness, its employee, White, testified that the lockout for the free-wheel was only considered as an emergency control, whereas the making of the positive non-over-running connection in the petitioner's device was an integral part of his transmission.

The respondent does not deny that the so-called free-wheeling device (Exhibit "R"), had never been mentioned before the trial, and that there wasn't a physical exhibit of the "1930" device produced at any time by the respondent. It does not deny that the exhibit, upon which it depends entirely, in accordance with the statement in the third paragraph at page "2"* , consists "of lines, letters, and numbers but with no description showing its function, Exhibit 'R', was the only thing offered to support the contention" (which we maintain and clearly establish is erroneous) "that the '1930' free-wheeling device employed three of the five elements disclosed by the petitioner."

The respondent does not deny that, the "locking out of the free-wheeling of the '1930' device, does not perform the same function as the making of a positive non-overrunning connection in the petitioner's and the accused devices."

The respondent does not deny, that it "at no place contended nor did the district court hold, that the '1930' free-wheeling device referred to by the Court of Appeals, plus the respondent's additions, anticipated the petitioner's invention", and it does not

* Refers to Respondent's Brief.

deny that "there is not a word of testimony, or evidence, to support such a holding in the district court."

The respondent does not deny that the Keller patent, No. 1,734,491, Exhibit "N", cannot overdrive. The respondent does not deny that the holding of the Court of Appeals, to the effect, that the petitioner's device can overdrive, conflicts with the holding of the district court. The respondent does not deny that "there is no evidence that the petitioner's combination of elements were known before the petitioner's disclosure." The respondent does not deny that it "offered no proof that this '1930' device embraced the overrunning, the sliding shaft and the positive non-overrunning connection, three of the elements of the petitioner's device."

The respondent, although at page "8"* it discussed the point at length, it does not deny our claim on page "15" of the petition that "The *movement* of the shaft itself in combination with the other elements was one of the elements disclosed in the description (Exhibit 3c) and not the means of moving it (R. 312). The Court of Appeals ignores the overdrive feature of petitioner's device in that particular holding." The respondent does not deny that "Through its employees, the respondent applied for patents covering the overdrive and had them assigned to it."

Respondent contends erroneously, we did not claim overdriving in the Court of Appeals. It contends, therefore, that respondent, which received the petitioner's description and drawing disclosing overdriving, in confidence, was entitled to use the petitioner's invention without compensating petitioner. The respondent contends that it should be entitled to the benefit of a holding favorable to it, pertaining to that

* Refers to Respondent's Brief.

which it did not claim. It never claimed that the "1930" device anticipated petitioner's invention, either in any pleading, at the trial, or in the Court of Appeals. It contends that the petitioner should not be entitled to the benefit of a holding favorable to him (R. 393) that he *did* claim, namely, that petitioner's device does overdrive.

We respectfully submit that if there ever had been a claim by the respondent that the "1930" device anticipated the petitioner's device, or if it were a fact that the "1930" device anticipated the petitioner's device, or if it was claimed that the "1930" device had a sliding shaft in it, Mr. Gritzbaugh of the respondent, referred to in the deposition of Richard T. Graham (R. 382-390), certainly would have mentioned it to Mr. Graham at the time of the conversation, for he had the occasion to do so (R. 386).

Answer to the Respondent's Comments on Petitioner's Reasons for Granting the Writ.

The reasons set forth in the petition for granting the writ to which respondent's brief is directed are:

1. The foundation for the concurrent findings of the Second Circuit Court of Appeals material to the determination of the issues herein, should be examined by this court and after examination should be set aside.

2. The holding of the Second Circuit Court of Appeals is contrary to the decisions of this court.

3. The evidence established a confidential relationship between the parties, a disclosure of a novel invention, its appropriation and use by the

respondent and an implied agreement for compensation by the respondent to the petitioner contrary to the holding of the district and circuit courts.

4. The holding of the Second Circuit Court of Appeals is an innovation unsupported by any decision in holding, in effect, that the petitioner makes no claim for a principle that was used by respondent, although the complaint alleges the respondent manufactured and sold a device using the invention of the petitioner, described in exhibits admitted in evidence, which included that principle, namely, overdriving.

5. The holding of the Second Circuit Court of Appeals is of far reaching consequence and importance in that it would confuse the several Circuit Courts of the United States in interpreting the prior decisions in this court in reference to the unauthorized use by a transgressor who appropriates part or all of novel invention.

Reasons "6" and "7" are not referred to in the respondent's brief, excepting to describe them as general prayers for relief.

The respondent's brief superficially challenges those grounds.

1. The statement in respondent's brief with regard to reason "1" is inaccurate because the decisions of the two Courts below were not the same. This, we have demonstrated in the petition for the Writ of Certiorari. For instance, the district court held that the petitioner's device was not capable of overdriving (R. 373). The Court of Appeals held that the petitioner's device *was* capable of achieving

overdriving (R. 393). The district court made no reference whatsoever to the alleged "1930" free-wheeling device (R. 356 et seq.), and the Court of Appeals based its decision on the existence of the alleged "1930" free-wheeling device (R. 395) which the respondent never had contended, anticipated the petitioner's device.

2. The respondent cannot be serious in its contention with regard to reason "2", and, we believe, that pages "26" to "30" of the petition support that reason completely.

3. The respondent is in error in its contention with regard to reason "3", as we have established in substance, all the necessary elements to warrant this Court in granting the Writ.

4. The grounds directed to reason "4" in the respondent's brief appear to be confusing. However, nothing that the respondent might state can erase the fact that in the very first letter by the petitioner, Exhibit "1", he advised the respondent, in effect, that his device was capable of overdriving. The testimony by the respondent's chief engineer (R. 243), where he described the transmission disclosed by the petitioner "going from a zero speed or neutral up through an infinite range of speeds * * *", and the allegations in the complaint to the effect that the respondent makes use of the petitioner's transmission in the manufacture of transmissions, naming among others, the "automatic overdrive" specifically, amply supports the claim to overdriving. (Paragraph "Fiftieth" of the complaint, R. 13).

The statement in respondent's brief at page "4"*

"Reason 4, * * * The Court of Appeals * * * is stating *as a fact* that the description did not set forth or contemplate the principle of overdrive. Such a principle is not mentioned in the description (the only grounds upon which relief could be granted). * * *"

is erroneous on several counts. The Court of Appeals held that the petitioner's device could overdrive (R. 393).

Exhibit "3c" in the following words, in at least one place, described and contemplated overdriving.

"Generally described, the invention provides a power transmission * * * by which any desired speed reduction can be obtained over a suitable range. * * *" (R. 307).

The petitioner described his device also in the drawings, Exhibit 3b and Exhibits 1 and 3a. Overdriving, in itself, is merely a gearing up (R. 263), making the driving shaft revolve faster than the driven shaft.

5. The remarks in respondent's brief in respect of reason "5" completely ignore the existence of the case of *Morgan v. Daniels, supra*. The statements at page "5" in respect of reason "5" completely lose sight of the decisions set forth on pages 26 to 31, inclusive, of the petition, as well as the cases set forth in the brief in support of the petition for the Writ of Certiorari.

The Petitioner's Reasons are far from a request

* Refers to Respondent's Brief.

that the Court review the case for the "purpose of re-examining the correctness of the result." This is an application to this Court to examine the record and upon the Court finding there is no credible evidence to sustain the necessary findings, that it reverse the decisions of the lower courts.

However, the failure of the respondent to deny the statements referred to at pages 10, 11, 12, 14 and 15 of the petition, which are designated at pages 4, 5 and 6 of this Reply, we respectfully submit is an admission that those statements are true.

The failure of the respondent to point out any evidence that would establish that the "1930" device had a sliding shaft, we respectfully submit, constitutes an admission that it had no sliding shaft. An examination by this Court, we believe, will disclose that the indispensable findings of fact are without foundations and upon the ascertainment of the real facts, we submit, that this Court will apply the proper legal tests. Upon the completion of the investigation along this line, we believe this Court will determine that the findings are not supported by the testimony or the exhibits, or both together.

Answer to "Other Pertinent Comments on Petition and Brief."

1. The statement that the complaint was dismissed as to the defendants in the district court, other than Borg-Warner Corporation, in an unappealed from ruling we challenge, as the appeal was taken from all dispositions, unfavorable to the petitioner, made by the district court, there being no necessity to note any exception to the ruling of the Court.

2. The foregoing applies to the statement in paragraph "2" on page "5"*. We challenge the statement that the dismissal of the fraud and conspiracy causes of action is an unappealed from ruling.

3. We challenge the statement that the established facts have twice been held to prove that respondent's devices are not in any sense of the word an appropriation of petitioner's invention. The Court of Appeals in its ruling held that both the accused and petitioner's devices have an overrunning feature, longitudinal shaft, axially slidable, and a positive non-overrunning connection. The Court of Appeals, in substance, in holding that the petitioner's device was also capable of overdriving held, in effect, that the accused device did all that the petitioner's device did, excepting the automatic changing of the speeds.

4. The statement at page "6"*, that the description, which is Exhibit 3c (R. 306-314) was nothing more or less than a copy of a patent application is incorrect. There are paragraphs in Exhibit 3c that are not at all contained in the patent application, which a comparison will readily show. The description, Exhibit 3c, is broader than that which is contained in the specification in the patent itself, and the statement, therefore, that the patent is a measure of the invention contained in the description submitted, is without basis. Exhibit 3c differs from the patent application. For instance, the words in folio 920 of the record, which are part of Exhibit 3c,

"The advantages of the invention as here outlined are best realized when all of its features

* Refers to Respondent's Brief.

and instrumentalities are combined in one and the same structure, but, useful devices may be produced embodying less than the whole.

It will be obvious to those skilled in the art to which this invention appertains, that the same • may be incorporated in several different constructions. The accompanying drawing, therefore, is submitted merely as showing the preferred exemplification of the invention."

do not appear in the patent at all.

5. The statement, to the effect, that the petitioner unsuccessfully urged patent number 1,968,030 in respect of the same devices complained of here is quite inaccurate. At the time the patent suit was instituted there was only one device being manufactured by the respondent. The statement that the patent suit was defended by respondent, Borg-Warner, to the knowledge of the petitioner is misleading. The suit was started in 1937, and it was not until 1940, two years after the default of the petitioner, that the letter referred to in the respondent's brief and referred to at page 346 of the record, was received.

The statement, "Thus patent infringement has been adjudicated adversely to Petitioner, although, because of certain equities present, the case was dismissed and final judgment was entered without need for a trial", is misleading.

Neither the district court nor the Court of Appeals sustained the defense of *res judicata* referred to at page "6"* , which was before both Courts. This defense was based on a dismissal for default of the petitioner in a patent suit instituted in February, 1937, against the Chrysler Sales Corporation, alone.

* Refers to Respondent's Brief.

The case at bar was brought to recover damages based on the abuse by the respondent, of the confidential relationship existing between the parties, fraud, conspiracy and breach of contract. After negotiations in 1931 and 1932, between the petitioner and the respondent for the manufacture or purchase by the respondent of the petitioner's device were ended, the respondent, by its very actions, in violation of the obligation imposed upon it, made itself liable to the petitioner.

Not a single line of testimony was taken in the patent suit (R. 49). Not one exhibit was offered by either the petitioner or the Chrysler Sales Corporation, the defendant. Neither of the courts below, found any prior proceeding was *res judicata*, either as a fact or a matter of law. No issues were ever tried before the case at bar was tried.

That the patent suit may not be regarded as *res judicata* is established by the rule laid down in the cases of ²*Hughes v. United States*, ³*Smith v. McCool*, ⁴*Jones v. Gould*, ⁵*Pueblo De Taos v. Archuleta*.

There were four devices, manufactured by the respondent (R. 171). A different device was used in automobiles after the 1936 models were marketed (R. 173). The patent suit dealt with the first device used prior to the institution of that suit in 1937.

The complaint in the patent suit was verified in February, 1937 (R. 335), and was against the Chrysler Sales Corporation only. That suit covered the use of Exhibit "19". Exhibit "19" was not manufac-

² *Hughes v. United States*, 71 U. S. 232 (4 Wallace 232), page 238.

³ *Smith v. McCool*, 83 U. S. 560, page 561.

⁴ *Jones v. Gould*, No. 1, 145 App. Div. 271, page 275.

⁵ *Pueblo De Taos v. Archuleta*, 64 Fed. (2d) 807, page 812.

Exhibit "15" was not put into any car until after 1936. 937 (R. 173), after the petitioner's complaint in the patent suit was verified.

The device complained of in the patent suit could not be the same device as Exhibit "15", which did not appear until after the New York patent suit was started in February, 1937 (R. 173).

The statement in paragraph "6" at page "6"* is inaccurate. The petitioner's device was also described in Exhibits "1" and "3a" and was described by the respondent's chief engineer (R. 243) when he stated "The disclosure showed * * * a variable speed mechanism going from a zero speed or neutral up through an infinite range of speeds. * * *"

The finding of the Court of Appeals that the petitioner's device was capable of overdriving (R. 393), completely nullifies the contention of the respondent that there was no thought of overdriving expressed by the petitioner.

Furthermore, in the complaint, the petitioner alleged that the respondent made use of the petitioner's invention. He named specifically the "Automatic Over-Drive" (R. 13, 15). Since the word *overdriving* contemplates the causing of the driven shaft to revolve at a greater speed than the drive shaft, as described at page "3"*, the contention of the respondent that there was no thought of *overdriving* on the part of the petitioner is without foundation.

A reading of paragraph "7", at page "6"*, indicates that the respondent has either failed to read or has misread the opinion in the case of *Diamond Rubber Co. v. Consolidated Tire Co.*, pages 435 and 436 of 220 U. S., in which the Court held that an

* Refers to Respondent's Brief.

inventor is entitled to all that his patent covers even if its complete capacity is not recited, and is unknown to him at the time the patent issued.

The statement at the bottom of page "6" and top of page "7"* that the petitioner contended before the Court of Appeals that "No claim is made for the principle of overdrive" is quite inaccurate. The petitioner necessarily makes claim for, and is entitled to everything his invention can achieve (*Diamond Rubber Co. v. Consolidated Tire Co., supra*).

In the petitioner's reply brief before the Court of Appeals, not only did the petitioner claim for the principle of overdrive, but in proof of that, established that the petitioner's device could overdrive and that the Keller patent, Exhibit "N", which respondent claimed anticipated petitioner's invention, could not overdrive, showing one of the twelve comparisons in which the petitioner's and the device of the accused differed from the Keller patent.

Further proof of the fact that the petitioner claimed overdriving is contained in the following quotation describing overdriving, from the petitioner's brief before the Court of Appeals:

"* * * When lever 17 moves toward pivot 27, the gear or leverage ratio decreases. When arm 17 moves toward link 13, the gear or leverage ratio increases, so that when the lever 17 nears 27, it is underdriving. When the lever 17 moves in the opposite direction towards link 13, as it nears link 13 it *overdrives*, meaning there will be more revolutions per minute of the driven shaft than the driving shaft." (Italics mine.)

"The foregoing description is condensed from

* Refers to Respondent's Brief.

the petitioner's disclosure to respondent, Plaintiff's Exhibit 3c, at folios 923, 924, 925, 926, 927, 936 and 937. Particular attention is directed to folio 927 stating that the ratio of the arms of the lever can be changed, *i. e.*, the gear ratio or power ratio equivalent."

In addition to the foregoing, the petitioner produced before the Court of Appeals, a physical model of that part of his device above described, and demonstrated conclusively to the Court that his device could overdrive. In the face of all of the foregoing, the respondent's contention that no claim was made for overdriving, may not be taken seriously.

Since the Court of Appeals found that both the petitioner's and the accused device have the over-running feature, the longitudinal shaft, means for sliding the shaft axially (manually, or in any other desired manner) and the positive non-overrunning connection (R. 395) and since the Court of Appeals held that the petitioner's device was capable of overdriving (R. 393) from the description, drawing and evidence, it would seem that the petitioner had established all the facts necessary to succeed.

Referring to the statement in paragraph "8", at page "7"* , we believe, that the Court of Appeals has established, in effect, that the respondent used all of the elements of the petitioner's invention that are necessary to enable it to manufacture the overdrive, even though that Court held, and we believe erroneously, that the respondent had manufactured a device employing only some of the principles of the petitioner's device before petitioner's disclosure.

The statement in paragraph "7", top of page "7"*

* Refers to Respondent's Brief.

to the effect that the petitioner contended that it made no claim for the principle of overdrive before the Court of Appeals is misleading, in view of the fact, that the petitioner actually produced part of the petitioner's device and showed that Court just exactly how it did accomplish overdriving.

Referring to the statement in paragraph "9", at page "7"* , we respectfully direct the Court's attention to the fact that the respondent has failed to show where in the record, there is anything to support the holding of the Court of Appeals that the "1930" device had a sliding shaft. The district court did not consider the "1930" device. We also direct the Court's attention to the fact that the respondent has failed to point out where in the record there is any credible evidence to support Findings "9", "10", "15", "17" and "18", and without those Findings the respondent must fail.

Significant is the fact that no reference is made in respondent's brief to page 19 of the petition.

As to the statements in paragraph "10", at page "7"* , the fact that the inventor obtained a patent, establishes *prima facie* evidence of novelty (¹*Morgan v. Daniels, supra*). We believe, that the evidence clearly showed and the Court of Appeals found, in effect, that the respondent used the petitioner's elements, namely, of (a.) overrunning, (b.) longitudinal shaft, (c.) sliding of the shaft, (d.) overdriving, (e.) the positive non-overrunning connection of the drive and driven shafts.

Referring to paragraph "11" at page "7"* , the decision of the Court of Appeals adverse to the petitioner, depends upon the finding of that Court, that

* Refers to Respondent's Brief.

the respondent manufactured the "1930" device, which the Court of Appeals held contained, among other things, "shafts axially slidable".

It is important to point out that even *now* the respondent does not claim that the "1930" device had a sliding shaft. The statement by the respondent, "Petitioner seems to question (at this late date) the fact that Respondent in 1930 manufactured a free-wheeling (overrunning) transmission having a manual lockout (or cutout) to direct connect the drive and driven shafts (sometimes called by Petitioner a 'positive non-overrunning connection')", is misleading. In neither the district court, nor in the Court of Appeals did the respondent contend that the "1930" device anticipated the petitioner's invention. The respondent did not produce, at any time, a physical exhibit of the "1930" device for the obvious reason that it does not contain a sliding shaft. It was not until now, *after* the Court of Appeals' "(at this late date)" decision that it was necessary to question the holding that the "1930" device, in part, anticipated the petitioner's invention, or was even manufactured by the respondent. It is significant, however, that in that whole sentence on page "7"* , the respondent does not contend that the "1930" device contained *a slidable shaft*. There is nothing in the exhibit (R. 352), that is competent to prove anything or that shows it contains a sliding shaft.

There is not one single word in Mr. White's testimony referred to at page "8"* and his is the only testimony dealing with the "1930" device that suggests, that the "1930" device had a sliding shaft.

There is no testimony whatsoever that the "1930" device had a sliding shaft and not a suggestion of

* Refers to Respondent's Brief.

such testimony or such evidence in the whole of the respondent's case. This was claimed in the petition at page 19, but it has not been denied by the respondent in its brief in opposition.

Referring to paragraph "12", at page "8"* , the respondent here attempts to by-pass all cases decided by this Court holding that a combination of old elements, producing a new and useful result is novelty (⁶*Loom Co. v. Higgins*, ⁷*Parks v. Booth*, ⁸*Bates v. Coe*).

The statement in paragraph "12" at page "8"* ,

"* * * Obviously Petitioner was not the first to connect drive and driven shafts together. This admittedly was done in the prior art free-wheeling devices (R. 352), as well as in many other prior art power transmission devices."

is valueless. It does not refer to a *sliding* shaft, which is one thing claimed for the petitioner's device and is not contained in the "1930" device; it does not refer to the combination of elements that is claimed for the petitioner's device; it does not say who admits that the petitioner was not the first to connect the drive and driven shafts together. There is nothing establishing that this was done "in the prior art free-wheeling devices", and there are neither words, description nor symbols in Exhibit "R" at page 352 of the record, that show or describe either the existence of a sliding shaft or the means to connect drive and driven shafts or anything else. We believe, that if there were a sliding shaft in Exhibit "R", Mr.

* Refers to Respondent's Brief.

⁶ *Loom Co. v. Higgins*, 105 U. S. 580.

⁷ *Parks v. Booth*, 102 U. S. 96.

⁸ *Bates v. Coe*, 98 U. S. 51, page 58.

White, the respondent's chief engineer and during whose testimony it was introduced in evidence, would have testified as to the sliding shaft and pointed it out. Mr. White, we believe, is not only an engineer but is also the inventor of this "1930" device.

The record shows that the accused device, the "overdrive", used those elements in the petitioner's device, namely, (a.) the overrunning, (b.) the longitudinal shaft, (c.) the sliding of the shaft, (d.) the means for accomplishing overdriving, (e.) the positive non-overrunning connection of the drive and driven shafts, necessary to manufacture the accused device. It appears from the record that the accused device was not manufactured by the respondent before the disclosure by the petitioner in October, 1931. The overdrive was not marketed until 1934 (R. 248). These uncontroverted facts we respectfully submit, under the cases cited in the petition and brief, merit the consideration of this Court. An investigation of the facts and law, we believe, will satisfy this Court that petitioner's application for a Writ of Certiorari should be granted.

The wide spread importance of the questions involved here we do not believe has been challenged successfully by the respondent.

From a reading of the record, the respondent's brief, the opinions of the two Courts and the proofs adduced by the petitioner, we come to the inescapable conclusions,

(a.) That the petitioner's invention was novel to the respondent (R. 301 to 328).

(b.) That the respondent had not manufactured the "overdrive", a device using the principles of the

petitioner's invention before 1931 (R. 248), when the petitioner sent to the respondent his description and drawings showing the operation of his device (R. 302).

(c.) That the respondent in its "overdrive" used the elements of the invention of the petitioner (R. 395).

(d.) That the respondent manufactured the overdrive, which is described as the "Cruise and Climb Transmission", "Automatic Over-Drive", "Automatic Overtake" and "Gas Saver Transmission" (R. 13 and 23) using the necessary elements of the petitioner's invention after he disclosed them to it.

(e.) That the said "overdrive" was marketed for the first time in February, 1934 (R. 248).

(f.) That the petitioner's mechanism is capable of overdriving (R. 393).

(g.) That the Keller Patent, No. 1,734,491, Exhibit "N", did not anticipate the petitioner's invention.

(h.) The respondent appropriated and used so much of the invention disclosed by the petitioner as was necessary to enable the "overdrive" to function.

(i.) That the "1930" device did not contain a sliding shaft and therefore it cannot be said to have anticipated the petitioner's device in any respect (R. 352, 208 to 210, 243, 262-265).

We believe, we can show that neither the district court nor the Court of Appeals understood the mechanical devices before them. The respondent's counsel admitted that its device was very complicated (R. 257).

The respondent's quotation and reference at page "5"* to the case of *Magnum Co. v. Coty*, 262 U. S. 160, is without merit. There the applications to this Court were for orders to suspend interlocutory decrees of the Circuit Court of Appeals pending applications for certiorari.

There are other reasons for granting the Writ, but since the material foundations for the findings in the lower Courts are absent, we respectfully submit that this Court should grant the Writ.

CONCLUSION.

The reasons for granting the Writ remain as stated in the petition, and petitioner prays that the Writ be granted.

Respectfully submitted,

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* Refers to Respondent's Brief.